

Summary of the Claimed Subject Matter

The invention relates to a hook which is fitted over the top of a door and more particularly an over-the-door hook capable of being used with doors having different thicknesses.

There are two independent claims on appeal, claims 1 and 10. Claims 3 and 6 through 9 depend from claim 1. Claims 12 through 15 depend from claim 10. There are no means plus function clauses in any of the claims on appeal.

Over-the-door hooks all tend to have a U-shaped body in which the base of the U-shape rests on top of the door and the sides of the U-shape extend down either side of the door. In claim 1 the U-shaped body is defined to have a top member, front side and back side, the sides each having an inside surface. Claim 1 further requires a hook member attached to the front side, a second hook member attached to the backside and "a hinge element provided in the back side such that the second hook member is pivotable in a direction toward the front side from a first position in which the back side and the second hook are in a common plane to a second position in which the second hook is substantially parallel to the back side and to the common plane of the first position, wherein with the second hook member in the second position the second hook member and the front side are separated by a second distance less than the first distance."

A hook within claim 1 is shown in Figures 1 through 3 of the application and described in the specification at page 6, line 16 through page 9, line 11. The hook has a U-shaped bracket 12 having a top member 14, front side 16 and back side 11. A hook 24 is attached to the front side. A second hook 26 is attached to the back side. The back side and hook lie in a common plane as shown in Figure 1. A hinge element 28 is provided in the back side which allows the second hook to be pivoted to a second position shown in dotted line in Figure 1. At the second position

the hook is parallel to the back side and to the plane through the back side and in which the second hook was originally located. Consequently, the distance between the second hook and the front side is less when the hook is in the second position. Because of the hinge the door hook defined by claim 1 can be used on doors of different thicknesses. The second hook will be in a common plane with the back side when the hook is placed on a thicker door. The second hook will be substantially parallel to the back side when the door hook is placed on a thinner door.

Claim 10 is similar to claim 1 but does not require a hook on the back side. Instead, the claim requires a spacing member attached to the back side. There must also be "a hinge element provided in the back side such that the spacing member is pivotable in a direction toward the front side from a first position to a second position in which the spacing member abuts the inside surface of the back side and faces the inside surface of the front side, wherein with the spacing member in the second position the spacing member and the front side are separated by a second distance less than the first distance."

Claim 10 reads on the hook shown in Figures 1 through 3. The second hook 26 shown in these Figures could be the spacing member of claim 10. However, at page 9, lines 12 through 18, the specification teaches that another spacing member could be used. "A hemispherical shape may replace the curved hook 26. Any shape which provides the desired spacing may be used." (page 9, lines 17-18).

Grounds of Rejection

The Examiner has rejected claims 1, 3 and 6-9 under Section 112 saying that the phrase "the back side and the second hook are in a common plane" is unclear. She also says that the phrase "wherein the second hook member in the second position the second hook member and the front side and separated by a second distance less than the first distance" is unclear.

All the claims on appeal were rejected based upon a single reference, United States Patent No. 6,082,686 to Schumann. Claims 1, 3, 6, 8-10 and 12-14 were rejected under section 102(b) . Claims 7 and 15 were rejected under Section 103.

ARGUMENT

A. The Examiner erred in rejecting claims 1, 3 and 6-9 under Section 112.

1. The phrase at lines 11 and 12 of claim 1 is clear.

The words of a claim are generally given their ordinary and customary meaning as would be understood by a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective date of the patent application. Phillips v. AWH Corp., 415 F.3d 1303, (Fed. Cir. 2005) (en banc). The specification is of a central importance in construing not only the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification. *Id.*

Claim 1 contains the phrase "the back side and the second hook are in a common plane." The phrase "in a common plane" and similar terminology are often used in patent claims to describe the relative position of structural elements. In Texas Instruments, Inc. v. Cypress Semiconductor Corp., USPQ2d, 1492 (Fed. Cir. 1996), the claim required "a plurality of conductors arranged in a substantially common plane . . . " These conductors were three dimensional structures. The court instructed the jury that the quoted language requires that "the conductors must be on the same plane, except for minor deviations."

Figures 1 and 2 of the application show the back side 18 and the second hook 26 in the same plane. The second hook 26 is a J-hook (see page 7, line 1 of the specification) and the straight portion of the J-hook is on the same plane as the back side 18. Therefore, the phrase "the

back side and the second hook are in a common plane" are clear and would be understood to mean that both structures are on the same plane.

2. The Examiner incorrectly quotes lines 13-15 of claim 1.

The phrase "wherein the second hook member in the second position, the second hook member and the first side and separated by a second distanced less than the first distance" does not appear in claim 1. The Examiner failed to include the word "with" after "wherein."

A phrase similar to this phrase appears in claim 10 except that "are" precedes "separated" in claim 10. Since no objection was made to claim 10 it appears that the objection relates to the use of "and" rather than "are. " If so, the objection could be overcome by replacing "and separated" with "are separated." If that be the case, the Examiner should have made this suggestion which applicant would have accepted.

The incorrect quotation of the claim language coupled with the failure to suggest a way to overcome the objection make the 112 rejection so unclear as to be unable to be addressed and is improper.

B. The claims are not anticipated by Schumann.

United States Patent No. 6,082,686 discloses a holding device which is attached to a flat surface by an adhesive strip. There is no teaching or suggestion that this hook could be placed upon a door. Nevertheless, the Examiner at page 4 of the Final Office Action attempts to find all the elements of claim 1 in the embodiment shown in Figure 5c of the '686 patent. However, they simply are not there.

Claims 1 and 10 require a U-shaped bracket in which there is a top member, a front side attached to one edge of the top member and a back side which is attached to another edge of the

top member opposite the one edge. The structure identified by the Examiner as the front side in Figure 5c of the '686 patent is not attached to the top member, but is attached to a spacing member that is attached to what the Examiner regards as the top member. If one considers the spacing member to be part of the front side, then both the front side and the back side are attached to the same edge of the top member. Claims 1 and 10 of the present application require the front side and back side to be attached at different edges of the top member.

Claims 1 and 10 also require a hinge in the back side that enables the second hook member or spacing member to move relative to the back side from a first position to a second position. The structure that the Examiner has identified as the "2nd hook member" in the '686 patent cannot move relative to what the Examiner has identified as the back side, namely the structure having the "back side inside surface" in the drawing on page 4 of the final Office Action.

At page 3 of the final Office Action the Examiner identifies the structure 21 in the '686 patent as "a back side (21) having an inside surface." But, in the drawings at page 4 of the final Office Action the same structure is labeled "Front side inside surface." The back side cannot have the inside surface of the front side as the front side and back side are different structural elements. Therefore, the rejection under Section 102 is wrong on its face.

For a proper Section 102 rejection, all limitations of the rejected claims must be found in the cited reference. In re Lange, 644 F.2d 856, 861, 209 USPQ 288, 293 (CCPA, 1981). Since many of the requirements of claims 1 and 10 are not present in the holding device disclosed in the '686 patent, the Section 102 rejection is not proper and should be reversed.

C. The claims are patentable under Section 103.

For the invention to have been obvious under Section 103 there must be a teaching or motivation to modify the prior art to create the claimed invention. In re Sernaker, 702 F.2d 989, 995-996, 217 USPQ 1, 6 (Fed. Cir. 1983).

Because several elements of claims 1 and 10 are not taught or suggested by the '686 patent, the claims on appeal are also patentable under Section 103 over that reference. Missing from the '686 patent are a U-shaped bracket as recited in applicant's claims and a hinge which enables the second hook member or spacing member to be moved from a first position to a second position relative to the back side. The holding device disclosed in the '686 patent is not an over-the-door hook and is used in an entirely different way than over-the-door hooks. Consequently, there is no teaching or motivation to modify the holding device of the '686 patent to create the claimed invention. For that reason, the claims on appeal are patentable under Section 103.

CONCLUSION

For the foregoing reasons the claims on appeal are patentable over the cited references.

Reversal of the rejections of the appealed claims are respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Lynn J. Alstadt", written in a cursive style.

Lynn J. Alstadt
Registration No. 29,362
BUCHANAN INGERSOLL, P.C.
One Oxford Centre
301 Grant Street, 20th Floor
Pittsburgh, PA 15219-1410
(412) 562-1632

Attorney for Applicant

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Claims Appendix

Claims 1, 3, 6 through 10 and 12 through 15 are involved in the appeal and presented in their current form below:

1. A door hook to be extended over a door top to both sides of a door, the door hook comprising:

a U-shaped bracket having:

a top member,

a front side which is attached to one edge of the top member, and

a back side which is attached to an other edge of the top member opposite the one edge, wherein the front and back sides are separated by a first distance;

a first hook member attached to the front side;

a second hook member attached to the back side; and

a hinge element provided in the back side such that the second hook member is pivotable in a direction toward the front side from a first position in which the back side and the second hook are in a common plane to a second position in which the second hook is substantially parallel to the back side and to the common plane of the first position, wherein with the second hook member in the second position the second hook member and the front side are separated by a second distance less than the first distance.

3. The door hook of claim 1, wherein at least one of the front and back sides are attached to the top member at an acute angle relative to the top member.

6. The door hook of claim 1, wherein the U-shaped bracket is made of one of styrene, polycarbonate and polypropylene.

7. The door hook of claim 1, wherein the top member is approximately 0.050 to 0.080 inches thick.

8. The door hook of claim 1 wherein the hinge element is a living hinge.

9. The door hook of claim 1 comprising at least one of a locking member and an adhesive on the back side which his positioned to retain the second hook member in the second position.

10. A door hook to be extended over a door top to both sides of a door comprising:

a U-shaped bracket having:

a top member,

a front side which is attached to one edge of the top member the front side having an inside surface, and

a back side which is attached to an other edge of the top member opposite the one edge, wherein the front and back sides are separated by a first distance, the back side having an inside surface facing the inside surface of the front side;

a first hook member attached to the front side;

a spacing member attached to the back side; and

a hinge element provided in the back side such that the spacing member is pivotable in a direction toward the front side from a first position to a second position in which the spacing member abuts the inside surface of the back side and faces the inside surface of the front side, wherein with the spacing member in the second position the spacing member and the front side are separated by a second distance less than the first distance.

12. The door hook of claim 10, wherein the first and second positions of the spacing member are 180-degrees apart.

13. The door hook of claim 10, wherein at least one of the front and back sides are attached to the top member at an acute angle relative to the top member.

14. The door hook of claim 10, wherein the U-shaped bracket is made of one of styrene, polycarbonate and polypropylene.

15. The door hook of claim 10, wherein the top member is approximately 0.050 to 0.080 inches thick.

Evidence Appendix

None.

Related Proceedings Appendix

None.